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EXAMINER

RINES, ROBERT D

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/992,764
Filing Date: November 06, 2001
Appellant(s): FLATT, JERROLD V.

MAILED

SEP 10 2007

GROUP 3600

Jeffery D. Hardy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 21 May 2007 appealing from the Office action mailed 6 November 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|--------------|---------------|---------|
| 2001/0051881 | Filler | 12-2001 |
| 2002/0082865 | Bianco et al. | 06-2002 |
| 2001/0034631 | Kiselik | 10-2001 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[2] Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Filler (United States Patent Application Publication #2001/0051881) in view of Bianco et al., (United States Patent Application Publication #2002/0082865).

[A] As per claim 25, Filler teaches a method of managing patient referrals, comprising: providing a web site accessible to a plurality of health care providers (Filler; paragraphs [0016] [0073] [0074]), the plurality of health care providers including a referring physician and a consulting physician (Filler; paragraphs [0028] [0029] [0032] [0047]); receiving a request on the web page from the referring physician for a patient consultation to be performed by the

Art Unit: 3626

consulting physician on a patient (Filler; paragraphs [0016] [0025] [0073]); and notifying the consulting physician of the request for a patient consultation (Filler; paragraphs [0025] [0076]).

Applicant has amended independent claim 25 to include limitations previously set forth in dependent claims 26 and 27 (cancelled as indicated in the current/26 July 2006 response).

Applicant has amended independent claim 25 to further limit the claim by requiring: requesting an authorization number for the patient consultation from an insurer providing insurance to the patient; wherein the step of notifying the consulting physician is notifying the consulting physician according to a preferred mode of communications setting set by the consulting physician on the web site.

As per these elements, Filler teaches requesting an authorization number for the patient consultation from an insurer providing insurance to the patient (Filler; paragraphs [0026] [0073] [0081] [0082]). NOTE: Filler does not specifically request an "authorization number" with respect to information exchanged with an insurer. However, Filler clearly indicates "an insurer of the patient may also be notified about the diagnostic service utilizing the network to facilitate payment" (Filler; paragraph [0026]). The examiner is interpreting the above statement by Filler to encompass the applicant's desire to obtain "an authorization number" from the patient's insurer.

Filler fails to specifically disclose that communications occur via a preferred mode of communication.

However, Bianco et al. disclose a method wherein the step of notifying the consulting physician is notifying the consulting physician according to a preferred mode of communications setting set by the consulting physician on the web site (Bianco et al.; paragraphs [0081] [0135] and Figs. 24A-24C).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Filler with those of Bianco et al. Such combination would have resulted in a web-based medical services network that enabled physicians to access a physician web site system for the purpose of referring a patient felt to be in need of a diagnostic or medical service (Filler; paragraphs [0016] [0017]). Further, such a system would have enabled physicians to register and log in to the system via a physicians' registration web page (Bianco et al.; paragraph [0132] and Fig. 24A). The motivation to combine the teachings would have been to enable a physician register with the system and enter biographical profile information and practice information (Bianco et al.; paragraph [0132]) into a searchable physicians' database such that other users of the system could access a physicians directory to search for the physician by name, specialty, or geographical location (Bianco et al.; paragraph [0098]), and upon identifying an appropriate physician, users could contact and communicate with the physician via an electronic message system or other contact information as designated by the physician (Bianco et al.; paragraph [0135]). Further motivation to combine the teachings would have been to provide an interactive, electronic patient healthcare system providing a full array of education and preparation tools for guiding a patient through a medical event (Bianco et al.; paragraph [0010]).

Claims 26 and 27 have been cancelled.

[3] Claims 1-3, 5-18, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filler in view of Bianco et al., and further in view of Kiselik (United States Patent Application Publication #2001/0034631).

[A] As per claim 1, Filler teaches a method of managing patient referrals, comprising: providing a web site accessible to a plurality of health care providers (Filler; paragraphs [0016] [0073] [0074]); receiving a request for a patient consultation from a first health care provider to be performed by a second health care provider (Filler; paragraph [0025] [0076]), both the first health care provider and the second health care provider having a health care provider registration (Filler; paragraph [0016]); and notifying the second health care provider of the request for a patient consultation (Filler; paragraphs [0025] [0076]).

Applicant amended the features of independent claim 1, as of the 26 July 2006 amendment, to include newly added limitation(s) and limitation(s) previously set forth in dependent claim 4 (cancelled as indicated in the current/26 July 2006 response). Applicant has amended independent claim 1 to further limit the claim by requiring: that notifying the second physician of the request for a patient consultation occurs according to a preferred mode of communication setting set by the second health care provider on the web site (newly added with respect to previously presented claim 1 and dependents) and further requiring receiving a peer rating from

Art Unit: 3626

the first health care provider of the second health care provider (previously of dependent claim 4).

Filler fails to specifically disclose both a peer rating system and setting a preferred mode of communication.

Regarding " preferred mode of communication", Bianco et al. disclose a method wherein notification occurs according to a preferred mode of communication setting set by the second health care provider on the web site (Bianco et al.; paragraphs [0081] [0135] and Figs. 24A-24C).

Although Bianco et al. includes provisions for a patient review of received quality of care, Bianco et al. fails to specifically disclose physician-to-physician peer review/rating.

Regarding peer ratings, Kiselik discloses receiving a peer rating from the first health care provider of the second health care provider (Kiselik; Abstract and paragraphs [0059] [0072]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Filler and Bianco et al., with those of Kiselik. Such combination would have resulted in a health services network that enabled a physician to access a physician web site system for the purpose of referring a patient felt to be in need of a particular diagnostic or medical service (Filler; paragraphs [0016] [0017]) and select an appropriate

Art Unit: 3626

physician, based on the physician's submitted personal and practice profile, from a physician's directory (Bianco et al.; paragraph [0132]) and contact the physician using contact information provided by the physician during registration with the system (Bianco et al.; paragraphs [0081] [0135] and Figs. 24A-24C). Such combination would have expanded on the physician and facility review functions of Bianco et al. (Bianco et al.; paragraph [0134]) such that a referring physician could view review/ratings of past performance of the physicians in the directory (Kiselik; paragraph [0004]). The motivation to combine the teachings would have been to effect rapid and accurate selection, by a referring physician, of a specialist or treating physician for a medical service and enable an evaluation based upon past performance of both physicians (Kiselik; paragraphs [0004] [0059]).

[B] As per claim 2, Filler teaches a method further comprising receiving a response from the second health care provider accepting or declining the request for a patient consultation (Filler; paragraphs [0076] [0047] [0073]).

[C] As per claim 3, Filler teaches a method further comprising scheduling a time for the patient consultation (Filler; paragraphs [0025] [0047]).

[D] Claim 4 is cancelled.

[E] As per claim 5, Kiselik teaches a method wherein the peer rating is anonymous (Kiselik; paragraph [0044]).

Applicant amended dependent claim 5. Claim 5 previously depended from claim 4. In the present/26 July 2006 response, Applicant has indicated that dependent claim 5 now depends from independent claim 1.

[F] As per claim 6, Kiselik teaches a method wherein the peer rating is attributed to the first health care provider (Kiselik; Abstract and paragraphs [0059] [0072]).

Applicant amended dependent claim 6. Claim 6 previously depended from claim 4. In the present/26 July 2006 response, Applicant has indicated that dependent claim 6 now depends from independent claim 1.

[G] As per claim 7, Kiselik teaches a method further comprising providing the peer rating to the second health care provider (Kiselik; Abstract and paragraphs [0059] [0072]).

[H] As per claim 8, Bianco et al., teaches a method further comprising providing a health care provider profile associated with a health care provider registration (Bianco et al.; paragraphs [0085] [0098] [0132]).

[I] As per claim 9, Filler teaches a method wherein the request for patient consultation includes patient demographic data (Filler; paragraph [0026]).

Art Unit: 3626

[J] As per claim 10, Filler teaches a method wherein the request for patient consultation includes insurance information (Filler; paragraphs [0026] [0047]).

[K] As per claim 11, Filler teaches a method wherein the request for patient consultation includes patient contact information (Filler; paragraph [0026]).

[L] As per claim 12, Filler teaches a method wherein the request for patient consultation includes appointment preference information (Filler; paragraph [0047]).

[M] As per claim 13, Filler teaches a method further comprising providing information concerning the request for patient consultation to an insurer (Filler; paragraph [0073]).

[N] As per claim 14, Filler teaches a method further comprising receiving notification of approval or denial from the insurer (Filler; paragraphs [0021] [0026] [0073]).

NOTE: Filler does not specifically utilize terms "approval" or "denial" with respect to information exchanged with an insurer. However, Filler clearly indicates "an insurer of the patient may also be notified about the diagnostic service utilizing the network to facilitate payment" (Filler; paragraph [0026]). The examiner is interpreting the above statement by Filler to encompass the applicant's desire to obtain "approval" or "denial" from the patient's insurer.

Art Unit: 3626

[O] As per claim 15, the method of claim 1 wherein the step of notifying is notifying via email (Bianco et al.; paragraphs [0081] [0109] [0135]).

[P] As per claims 16 and 17, while Bianco et al. indicates that email is primarily used to facilitate communications between and among users of the system (Bianco et al.; paragraph [0135]), Bianco et al., further indicates that "communication between the healthcare information provider system and patient and the medical practitioner may be established using any type of communication hardware and protocols which are already known in the art" (Bianco et al.; paragraph [0081]). The examiner interprets the above noted statement of Bianco et al., to be encompassing of the applicant's limitations of "notifying via fax" (claim 16) and "notifying via pager" (claim 17).

Regarding claims 2-3 and 5-17, the obviousness and motivation to combine as discussed with regard to claim 1 above are applicable to claims 2-3 and 5-17 and are herein incorporated by reference.

[Q] As per claim 18, Filler teaches a system for managing patient referrals, comprising: a web site accessible to a plurality of health care providers (Filler; paragraphs [0016] [0073] [0074]); and transmitting requests from at least one of the registered health care providers to at least one of the registered health care providers (Filler; paragraph [0025]).

Art Unit: 3626

Applicant amended the features of independent claim 18, as of the 26 July 2006 amendment, to include limitations previously set forth in dependent claims 19 and 24 (cancelled as indicated in the 26 July 2006 response). Applicant has amended claim 18 to further limit the claim by requiring: a peer review component for providing feedback to a patient consult by a consulting health care provider from a referring health care provider; a mode of communication preference set by a referring health care provider and provided to a consulting health care provider.

As noted in Examiner's rejection of claim 1 above, Filler fails to disclose setting a preferred mode of communication and both Filler and Bianco et al. fail to disclose physician-to-physician peer review/rating.

Regarding "a mode of communication preference", Bianco et al. disclose a method wherein notification occurs according to a preferred mode of communication setting set by the second health care provider on the web site (Bianco et al.; paragraphs [0081] [0135] and Figs. 24A-24C).

Regarding "a peer review component", Kiselik discloses a method including a peer review component for providing feedback to a patient consult by a consulting health care provider from a referring health care provider (Kiselik; Abstract and paragraphs [0059] [0072]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Filler and Bianco et al., with those of Kiselik. Such

Art Unit: 3626

combination would have resulted in a health services network that enabled a physician to access a physician web site system for the purpose of referring a patient felt to be in need of a particular diagnostic or medical service (Filler; paragraphs [0016] [0017]) and select an appropriate physician, based on the physician's submitted personal and practice profile, from a physician's directory (Bianco et al.; paragraph [0132]) and contact the physician using contact information provided by the physician during registration with the system (Bianco et al.; paragraphs [0081] [0135] and Figs. 24A-24C). Such combination would have expanded on the physician and facility review functions of Bianco et al. (Bianco et al.; paragraph [0134]) such that a referring physician could view review/ratings of past performance of the physicians in the directory (Kiselik; paragraph [0004]). The motivation to combine the teachings would have been to effect rapid and accurate selection, by a referring physician, of a specialist or treating physician for a medical service and enable an evaluation based upon past performance of both physicians (Kiselik; paragraphs [0004] [0059]).

[R] Claim 19 has been cancelled.

[S] As per claim 20, Bianco et al. teaches a system wherein the at least one registration web page includes a physician registration web page (Bianco et al.; paragraph [0132]).

[T] As per claim 21, Bianco et al. teaches a system wherein the at least one registration web page includes a clinic registration web page (Bianco et al.; paragraphs [0126] [0132]).

Art Unit: 3626

[U] As per claim 22, Bianco et al. teaches a system wherein the at least one registration web page includes a department registration web page (Bianco et al.; paragraphs [0126] [0132] [0134]).

[V] As per claim 23, Bianco et al. teaches a system further comprising a patient registration web page (Bianco et al.; paragraphs [0103] [0104]).

Regarding claims 20-23, the obviousness and motivation to combine as discussed with regard to claim 18 above are applicable to claims 20-23 and are herein incorporated by reference.

[W] Claim 24 has been cancelled.

(10) Response to Argument

In the Appeal Brief filed 21 May 2007, Appellant makes the following arguments:

(A) Bianco et al. fails to disclose the "preferred mode of communications" limitation recited in finally rejected claims 1, 18, and 25.

(B) The priority document relied upon by the Kiselik reference fails to support Kiselik's disclosure of a "peer rating from the first health care provider of the second health care provider" as recited in finally rejected claims 1 and 18.

(C) The priority document relied upon by the Filler reference fails to support Filler's disclosure that both the referring and the referred physician are registered with the website.

(D) Filler's provisional application fails to support Filler's disclosure of "notifying the second health care provider of the request for a patient consultation".

(E) Filler's provisional application fails to support Filler's disclosure of "a request for patient consultation that includes patient demographic data".

(F) Filler's provisional application fails to support Filler's disclosure of "various communications with insurance companies".

(G) Filler's provisional application fails to support Filler's disclosure of "appointment preference information".

Examiner will address the Appellant's arguments in sequence as they appear in the Brief.

Argument (A):

In response to Appellant's first argument that the Bianco reference fails to show a "preferred mode of communications", Examiner has applied the email/messaging and registration features of Bianco et al. to meet this limitation. Specifically, at Bianco et al. paragraphs [0109] and [0135], disclose that the email features utilized by the physician mimic those exemplified for patients. Accordingly, Examiner maintains that it stands to reason that the registration features provided patients are also utilized with regard to physicians. Bianco additionally evidences this parallel functionality directly at paragraph [0102]. Specifically, Bianco et al. depict a registration page in Figure 9C. that clearly indicates that the registering individual enters a "day time telephone number" an "evening telephone number" and an "email address". Examiner maintains that these communication entry fields and the resultant use of the messaging system disclosed by Bianco et al. constitute a "preferred mode of communication" under the broadest reasonable interpretation of the finally rejected claim language.

Examiner disagrees with Appellant's contention that Examiner's interpretation of the above noted features of Bianco et al. constitutes a "strained reading" of the Bianco reference. Examiner further submits that it is entirely unreasonable to assume that a physician would enter contact information that they prefer NOT to be used for communications. Accordingly, the fields must be used to enter contact information through which the physician "prefers" to receive communications.

Appellant further argues that Examiner "fills in disclosure" regarding the hardware configurations and "General Comments" features disclosed by Bianco et al. Examiner has applied the noted teachings merely to further emphasize that various hardware can be implemented as would be common practice (i.e., a pager associated with a phone number etc.) thereby providing opportunity for yet additional "modes" of communication. Examiner has applied the "General Comments" field in tertiary support merely to evidence that Bianco has considered providing the physician to further specify instructions as they see fit. Examiner maintains that this General Comments feature of Bianco would be available to convey standard conversational instructions such as "email is generally the best way to get in touch with me". Examiner re-emphasizes that the primary grounds for rejection of the claimed "preferred mode of communication" is the depicted email and telephone settings provided by the registering physician.

Art Unit: 3626

Argument (B):

As set forth in the previous Office Action mailed Examiner maintains that this feature/element is well known in the art as evidenced by...

In response to Appellant's second argument that the priority document relied upon by the Kiselik reference fails to support Kiselik's disclosure of a "peer rating from the first health care provider of the second health care provider", Examiner directs Appellant's attention to the peer rating features described by Kiselik's priority filing U.S. Patent Application #09/489,233 at pages 16 and 17. The noted pages evidence a practice/technique commonly employed in the e-commerce art that involves peer rating of parties involved in a transaction (page 17) such that "a rating and a history of performance... in previous transactions" (page 16) can be assessed by an individual employing the system. Examiner maintains that this teaching provides ample 35 U.S.C. 112, first paragraph, support for applying the noted practice to an e-commerce healthcare oriented system described by the applied Kiselik reference (US-PGPUB #2001/0034631).

Examiner notes that in many, if not most, situations, there is neither a motivation to make the modification clearly articulated in the references nor an evident lack of motivation. Rather, the prior art references typically disclose elements or aspects of the claimed subject matter, but fail to specifically point the way toward the combination, substitution or other modification needed to arrive at the invention. A judgment must be made whether "a person of ordinary skill in the art

Art Unit: 3626

would have sufficient motivation to combine the individual [elements] forming the claimed [invention]." See *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

Arguments (C)-(G):

In response to Appellant's third through seventh arguments, that the Filler provision application US #60/171,446 fails to support Filler's disclosure of various features relied upon by Examiner, Examiner submits that the noted features are either inherent or directly supported by the Filler provisional.

As to disclosure of "both the referring and the referred physician are registered with the website", page 1 of the Filler provisional indicates that "the managing medical entity (MME) assigns the patient to a contracted imaging center" (i.e., second physician). While the provisional refers to enrolled referring physicians, the provisional refers to the second physician (i.e., imaging center) as a "contracted" entity rather than "enrolled" entity. Examiner submits the term "contracted" indicates that the imaging center is entered (i.e., registered) into the system.

As to disclosure "notifying the second health care provider of the request for a patient consultation", page 1 of the Filler provisional indicates that "the patient contacts the IC or the IC and schedules the patient either by phone or through a web based scheduling system provided by the MME." By either route, the second health care provider is notified of the request for a patient consultation.

As to disclosure of "a request for patient consultation that includes patient demographic data", Examiner submits that entry of information identifying who the patient is (i.e. demographic data) is inherent to the process of patient referral described by Filler provisional.

As to disclosure of "various communications with insurance companies", claim 8 of the Filler provisional recites "generating appropriate billing and data tracking information for all data transmissions, receipts, transformations, and provisions of medical services". Examiner submits that this statement provides adequate 35 U.S.C. 112, first paragraph support for the natural next step of sending billing information to the appropriate paying entity (i.e., insurance companies).

As to disclosure of "appointment preference information", page 1 of the Filler provisional indicates that "the patient contacts the IC or the IC contacts the patient, schedules the patient either by phone or through a web based scheduling system provided by the MME." Examiner submits that appointment preferences of both the patient and imaging center are inherently supported by this disclosure.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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